

REMARKS

I. The Notice of Non-Compliant Amendment Applies an Incorrect Regulation for Reissue Applications

Applicants emphasize that the above-captioned application is a reissue application, which is governed by different regulations pertaining to amendments than other utility patent applications. By the Notice mailed June 9, 2006, the Office refused to enter Applicants' Amendment filed June 2, 2006 because the status identifiers of the claims did not comply with 37 C.F.R. § 1.121. It is improper for the Notice to refuse entry of Applicants' Amendment under 37 C.F.R. § 1.121 because section 1.121 does not govern amendments to claims in reissue applications. Instead, Applicants' Amendment should have been accepted as filed under section 1.173(b), which expressly governs amendments to claims in reissue applications. Applicants' Amendment conforms to the requirements of section 1.173 and, as such, should have been accepted by the Office.

Section 1.121(a) is captioned "Amendments in applications, other than reissue applications." Section 1.173, on the other hand, is captioned "Reissue specifications, drawings and amendments." As such, it is clear from the captions of these regulations that section 1.173 should be applied to Applicants' reissue application and that the Notice erroneously applied section 1.121 to an amendment in a reissue application.

II. The Amendment Filed June 2, 2006 Properly Complies with 37 C.F.R. § 1.173

Contrary to the conclusion contained in the Notice, Applicants' Amendment filed June 2, 2006 requests entry of properly identified claim amendments under section 1.173. Paragraph (2) of subsection 1.173(b) instructs Applicants:

For any claim changed by the amendment paper, a parenthetical expression 'amended,' 'twice amended,' *etc.*, should follow the claim number. Each changed patent claim or added claim must include markings pursuant to paragraph (d) of this section"

(emphasis added).

A quick review of section 1.173(b)(2) makes clear that only claims being changed by an amendment paper are given status identifiers, and then the only authorized status identifiers are

“amended,” “twice amended,” *etc.* Where Applicants are simply adding claims in an amendment paper (that is, new claims that are not being amended) Applicants are solely instructed by section 1.173(b)(2) to include “markings pursuant to paragraph (d).” Paragraph (d) instructs Applicants to underline new claims. Paragraph (d) does not authorize Applicants to provide status identifiers to new claims where those new claims are not changed by the amendment paper. As such, the regulations for amendments in reissue applications are clear, new claims that are not changed by an amendment paper are to be fully underlined and are not to be provided a status identifier.

The MPEP agrees with the above-provided analysis. MPEP § 1453 is captioned “Amendments to Reissue Applications.” Subsection (V) of section 1453 is captioned “Examples of Proper Amendments.” Paragraph C under subsection (V) is captioned “Presentation of New Claims.” Paragraph C provides Example 5 wherein new “Claim 7” is set forth as a proper example of a claim in a reissue application. A review of “claim 7” reveals it does not have a status identifier. Instead, “claim 7” is simply completely underlined.

In contrast to new “claim 7” in Example 5, the MPEP provides Example 2 as an example of a claim that is amended by the current amendment paper. MPEP § 1453(V)(A). “Claim 6” is provided a status identifier, “(Amended).” A comparison of Example 5 and Example 2 makes clear the MPEP instructs Applicants to present the claims exactly as provided in Applicants’ Amendment filed June 2, 2006.

In Applicants’ Amendment, Applicants provided status identifiers for all claims being “changed” by the “amendment paper,” just as required by 37 C.F.R. § 1.173(b)(2). For example, Claim 35, which is changed by the amendment paper, is provided the status identifier “(Amended)” and, since it is new, claim 35 is presented in completely underlined form. Claims 36-50, on the other hand, while new, are not changed by the amendment paper. Claims 36-50 are presented with no status identifier and in completely underlined form, just as provided in Example 5 at MPEP § 1453(V)(C).

If claims 36-50 were to have a status identifier, in contravention of section 1.173(b)(2), they might have the status identifier “New,” or, perhaps, “Previously presented,” but “New” and “Previously presented” are not status identifiers provided in section 1.173(b)(2). Instead,

Applicants properly present claims 36-50 fully underlined (as directed by 37 C.F.R. § 1.173(d)) to demonstrate that claims 36-50 are completely new, as compared to the issued patent, and have not been amended since their entry into the application.

CONCLUSION

In view of the above remarks, Applicants respectfully request withdrawal of the Notice of Non-Compliant Amendment dated June 9, 2006 in the above-captioned reissue application.

In the event that the filing of this Response is deemed not timely, Applicants petition for an appropriate extension of time. The petition fee may be charged to Kenyon & Kenyon LLP
Deposit Account No. 11-0600.

The Examiner is invited to contact the undersigned to discuss any issues related to this application.

Respectfully submitted,

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